RESPONSE AND REMARKS

I.   *REJECTIONS UNDER SECTION 112, SECOND PARAGRAPH*

In the Office Action, Claims 64-79 were rejected under 35 U.S.C. §112, second paragraph. *Office Action,* Topic No. 2, p. 2.

II.   *RESPONSE REMARKS REGARDING REJECTIONS UNDER SECTION 112 SECOND PARAGRAPH*

The rejections under Section 112 have been carefully considered. Claims 64, 68-69, 71-76, and 78-79 have been amended to more distinctly claim the claimed invention. It is respectfully asserted that the amendments to Claims 64, 68-69, 71-76, and 78-79 resolve the rejections under Section 112.

III.   *REJECTIONS UNDER SECTION 103(a)*

In the Office Action, Claims 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "*Kara*") in view of InterShipper; (Newsbytes Article, Internet Update; "*InterShipper*"), UPS® On Call Air Pickup (www.apps.ups.com; "*UPS On Call*"), UPS® Service Guide (www.ups.com; "*UPS*") and FedEx® Services (www.fedex.com; "*FedEx*"). *Office Action,* Topic No. 6, p. 3.

In the Office Action, Claims 68-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kara* in view of *InterShipper, UPS On Call, UPS* and *FedEx* and further in view of Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action,* Topic No. 11, p. 5.

IV.   *RESPONSE REMARKS REGARDING SECTION 103(a) REJECTIONS*

The rejections under Section 103(a) have been carefully considered.

As mentioned above, Claims 64, 68-69, 71-76, and 78-79 have been amended to more distinctly claim the claimed invention.

Reference is made herein to a previously-filed Declaration under 35 U.S.C. §132 by David Allison Bennett (filed on April 9, 2009 with Applicants' Amendment and

Response to the Office Action dated December 10, 2008), currently with iShip Inc. (a fully owned subsidiary of United Parcel Service of America, Inc., which is a fully owned subsidiary of United Parcel Service, Inc.), one of the assignees of the above-identified patent application ("*Bennett Declaration*" or "*Bennett Decl.*").

It is respectfully asserted, for the reasons given and authorities cited below, and in view of the evidence provided by the *Bennett Declaration* supporting the assertions herein of non-obviousness, that the claimed invention is not disclosed, anticipated, taught or suggested by the cited references and that the application is therefore in condition for allowance.

A.   NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE RECEIVING A USER'S SINGLE INPUT OF A PARTICULAR DESTINATION, PACKAGE SPECIFICATIONS AND A SHIPPING DATE, AND THEN DETERMINING, ACCORDING TO THAT SINGLE USER INPUT, SHIPPING RATES FOR MULTIPLE DELIVERY SERVICES FOR MULTIPLE CARRIERS AS CLAIMED BY THE AMENDED CLAIMS.

For the reasons given further below, it is respectfully asserted that none of the cited references, including *Kara*, or any combination of the cited references, disclose the combination of limitations claimed by the amended Claims for receiving a user's single input of a destination, package specifications and a shipping date, and then in response to receiving that single input, *determining shipping rates for multiple delivery services for multiple carriers*.

The Office Action states that "... the claims do not specifically disclose entering a specific ship date." *Office Action*, Topic No. 18, p. 9.

However, as compared to the above-mentioned assertion by the Office Action regarding the entry of a specific ship date (Office Action, Topic No. 18, p. 9), it is respectfully submitted that amended independent Claim 64 expressly claims "receiving, from a user, a user input ... comprising ... *an indication of a shipping date* ..." and then further claims determining various shipping rates "... *in response to receiving ... the indication of the shipping date* ...." *See also*, Claim 74 (claiming identifying various days for delivery "... in response to receiving an input by a user ... of ... a *particular shipping date* ...").

In rejecting Claim 64, the Office Action states that "… Kara discloses … [r]eceiving information from a user such as a set of package specifications (Figure 8, Box 802) and shipping information (See Figure 8) …." *Office Action*, Topic Nos. 7, 7a, p. 3; *see also Office Action*, Topic Nos. 12, 12.f, p. 5 (regarding rejections of Claims 68-79). Referring to "Boxes 807 and 808" of Figure 8 of *Kara*, the Office Action then further indicates that *Kara* discloses "… [d]etermining multiple shipping rates … for a first carrier … [and] [d]etermining multiple shipping rates for a second carrier …." *Office Action*, Topic Nos. 7.b. and 7.c., p. 3; *Office Action*, Topic Nos. 12.g. and 12.h., p. 5.

With regard to the above-mentioned assertion by the Office Action that *Kara* discloses "… [d]etermining multiple shipping rates … for a first carrier … [and] [d]etermining multiple shipping rates … for a second carrier …" (*Office Action*, Topic Nos. 7.b. and 7.c., p. 3; *Office Action*, Topic Nos. 12.g. and 12.h., p. 5), it is respectfully asserted that *Kara* discloses a "… program [that] may calculate and display fees associated with the shipping item … *according to the desired shipping and/or delivery parameters, i.e., class, urgency, etc.*" *Kara*, col. 22, lines 28-32 (emphasis added). With further regard to the above-mentioned assertion by the Office Action, it is respectfully asserted that *Kara* discloses a "… program [that] automatically calculates the fees for each shipping service provider offering services *commensurate with the desired shipping and/or delivery parameters.*" *Kara*, col. 22, lines 39-42 (emphasis added).

As compared to the aforementioned disclosures by *Kara* regarding calculating and displaying fees "… according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. …" (*Kara*, col. 22, lines 28-32; *see also Kara*, col. 22, lines 39-42), it is respectfully asserted that the amended Claims, *e.g.*, amended independent Claim 64, claim determining various shipping rates for multiple delivery services for multiple carriers, in response to receiving a user's single input of a destination, package specifications and a shipping date; the claimed limitations do not include the user inputting "… desired shipping and/or delivery parameters, i.e., class, urgency, etc. …" as disclosed by *Kara* in order to determine the shipping rates; the claimed limitations instead claim determining various shipping rates *for multiple delivery*

services for multiple carriers in order to facilitate displaying the various shipping rates.

That is, as compared to the aforementioned disclosures by *Kara* regarding calculating and displaying fees "... according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. ..." (*Kara*, col. 22, lines 28-32; *see also Kara*, col. 22, lines 39-42), it is respectfully asserted that the amended Claims, *e.g.*, amended independent Claim 64, claim determining shipping rates for *multiple delivery services* for multiple carriers in order to facilitate displaying the various shipping rates, and then claim displaying the various shipping rates so that the user can then, based on the user's comparison of the shipping rates, select desired shipping and delivery parameters, *i.e.*, a delivery service for a particular carrier.

For the above-given reasons, it is therefore respectfully asserted that amended independent Claim 64, and the Claims dependent on it, namely, Claims 65-73, are non-obvious in view of the cited references and are therefore in condition for allowance.

Similar to Claim 64 claiming determining shipping rates for multiple delivery services in response to receiving a single user input of a destination, package specifications and a shipping date, Claim 74 claims identifying delivery days for various delivery services "... "... in response to receiving an input by a user ... of ... a *particular shipping date* ...."

For reasons similar to those given above with respect to Claim 64, it is respectfully asserted that the cited references do not disclose identifying various days for delivery for various delivery services "... in response to receiving an input by a user ... of ... a *particular shipping date* ..." as claimed by amended Claim 74.

For the above-given reasons, it is therefore respectfully asserted that amended independent Claim 74, and the Claims dependent on it, namely, Claims 75-79, are non-obvious in view of the cited references and are therefore in condition for allowance.

B. ***Even Assuming for the Sake of Argument that a UPS Pickup Date is Equivalent to a Shipping Date, None of the Cited References, Including UPS, Even When Considered in Combination With Other Cited References, Disclose Determining Shipping Rates According to, Among Other Things, a Shipping Date as Claimed, For Example, by Amended Claim 64.***

In rejecting Claims 64 and 68-79, the Office Action asserts that "UPS discloses its on-call pick up which allows a user to schedule a pick-up with UPS, therefore receiving a shipping date ...." *Office Action*, Topic No. 9, p. 4; *Office Action*, Topic No. 14, p. 6. The Office Action further asserts that "... the day the carrier picks up the package is the shipping date, since it is out of the user's hands at that time and the shipping process is started (see Page 1) ...." *Office Action*, Topic No. 9, p. 4; *Office Action*, Topic No. 14, p. 6. The Office Action further asserts that "UPS also discloses the shipping rates being calculated according to shipping [d]ates, due to the fact that it calculates for Saturday Delivery." *Office Action*, Topic No. 9, p. 4; *Office Action*, Topic No. 14, p. 6.

First, even assuming for the sake of argument only that a scheduled pickup date is equivalent to the claimed shipping date, it is respectfully asserted that the Office Action's assertions regarding disclosure by the *UPS* and/or *UPS On Call* references of scheduling a pickup date are inapposite. The rejected claims are not directed to scheduling a pickup date, but rather, to determining a rate, and depending on the claim, a delivery date and/or a delivery time, according to a user input comprising a shipping date.

Further, it is respectfully asserted that, even assuming for the sake of argument, that a scheduled pick-up date is equivalent to a shipping date, the identification of a shipping date, by itself, does not disclose determining rates "according to [a] shipping date" as claimed, for example, by Claim 64. Moreover, it is respectfully asserted for the reasons given further below, that the above-mentioned assertions by the Office Action that "UPS also discloses the shipping rates being calculated according to shipping [d]ates, due to the fact that it calculates for Saturday Delivery ..." (*Office Action*, Topic No. 9, p. 4; *Office Action*, Topic No. 14, p. 6), reads more into the *UPS* and *UPS On Call* references than is actually disclosed by those references. Further still, and for the

reasons given further below, it is respectfully asserted that the *UPS* and *UPS On Call* references, even when considered in combination with the other cited references, fail to disclose determining shipping rates for multiple delivery services for multiple carriers according to, among other things, a particular shipping date as claimed by amended independent Claims 64.

In particular, for the reasons given and in view of the supporting evidence cited below, as compared to the limitations of amended independent Claims 64 for determining shipping rates for multiple delivery services for multiple carriers according to, among other things, a particular shipping date, it is respectfully asserted that the "Pickup Date" input field on the *UPS On Call* reference, asserted by the Office Action to be equivalent to a shipping date, does not appear to be used by the UPS "Quick Cost Calculator" in calculating shipping rates as claimed by amended Claim 64.

The *UPS On Call* reference discloses a pickup service, namely, the UPS® "On Call Air Pickup" service, and discloses input fields for scheduling a pickup of a shipment for various UPS® Air delivery services. *See UPS On Call*, ¶¶1-2. For that purpose, the *UPS On Call* reference shows input fields in a section labeled "Scheduling Information" for a "Pickup Location", a "Pickup Date", a time for a "Shipment [to be] Ready at", a "Pick Up by" time, and a "Continue" button. *UPS On Call*, "Scheduling Information." The *UPS On Call* reference explains that "UPS On Call Air Pickup service gives you the convenience of having your shipment picked up." *UPS On Call*, "Scheduling Information." That is, it is respectfully asserted that the input fields on the *UPS On Call* reference are provided so that a Pickup can be scheduled for shipment. It is respectfully asserted that the *UPS On Call* reference does not disclose that there would be any costs associated with the Pickup and does not indicate that any costs would be calculated or displayed if a user were to complete the above-mentioned input fields to schedule a Pickup and then click the "Continue" button under the "Scheduling Information" block of the reference. *See also, e.g., Bennett Decl.*, ¶ 20; *Bennett Decl.*, Exhibit H. Rather, in order to obtain costs, it appears that a user would need to activate the "Quick Cost Calculator" link, such as shown on the *UPS On Call* reference. *See UPS On Call*, ¶ 3; *see also, e.g., Bennett Decl.*, ¶ 20; *Bennett Decl.*, Exhibit H.

Moreover, and for the reasons given further below, it is respectfully asserted that the *UPS On Call* reference does not indicate that the information under the "Scheduling Information" section of the page must have first been input in order to click the "Quick Cost Calculator" link in order to calculate a rate. *See also, e.g., Bennett Decl.*, ¶¶ 22-23, 27-28, 31; *Bennett Decl.*, Exhibit H; *Bennett Decl.*, Exhibit J.

It is respectfully asserted that, using the same www.archive.org website that was apparently used by the Examiner to obtain the *UPS On Call* reference, it is possible to access an operational exemplar of the UPS® website page entitled "On Call Air Pickup." *See also, e.g., Bennett Decl.*, ¶¶ 6, 18; *Bennett Decl.*, Exhibit H. It is respectfully asserted that accessing the operational exemplar of the UPS® website page entitled "On Call Air Pickup" confirms the above-mentioned absence of consideration of a Pickup Date in the calculation further to the *UPS On Call* reference of a shipping rate. *See also, e.g., Bennett Decl.*, ¶¶ 32-33. More particularly, it is respectfully asserted, in view of the reasons given below, that the "Pickup Date" input field on the *UPS On Call* reference, asserted by the Office Action to be equivalent to a shipping date, does not appear to be used by the exemplar "UPS Quick Cost Calculator™" page in calculating shipping rates "according to a shipping date" as claimed by amended Claim 64.

It is respectfully asserted that when accessing the operational exemplar UPS® website "On Call Air Pickup" page, an operational exemplar "Quick Cost Calculator" Link is displayed. *See also, e.g., Bennett Decl.*, ¶¶ 20, 22. It is respectfully asserted that, whether or not data has been entered into all of the input data fields (including a Pickup Location, Pickup Date, Shipment Ready at time and Pick Up by time) on the operational exemplar UPS® "On Call Air Pickup" page, clicking on the operational exemplar "Quick Cost Calculator" Link on the operational exemplar UPS® "On Call Air Pickup" page will result in the display of another operational exemplar UPS® website page, entitled "UPS Quick Cost Calculator™." *See also, e.g., Bennett Decl.*, ¶¶ 22-23, 27-28, 31; *Bennett Decl.*, Exhibit J.

It is respectfully asserted that the operational exemplar UPS® "UPS Quick Cost Calculator™" page as depicted in Exhibit J to the *Bennett Declaration*, accessed from the operational exemplar UPS® "On Call Air Pickup" page, has an input section titled "ORIGIN" that provides input fields for an Origin Country and Postal Code; an input

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section titled "DESTINATION" that provides input fields for Destination Country, City and Postal Code, and that provides a Yes/No indicator for whether the Destination Address is a Residential Address; an input section titled "PACKAGE INFORMATION" that provides input fields for a Drop-off/Pickup selection, a Packaging Type, a Package Weight, and Package Dimensions; provides a "Calculate" button; and indicates that once the information for an item has been input, clicking the "Calculate" button will result in shipping charges being calculated. *See also, e.g., Bennett Decl.*, ¶ 24; *Bennett Decl.*, Exhibit J.

It is respectfully asserted that the operational exemplar UPS® "UPS Quick Cost Calculator™" page, accessed from the operational exemplar UPS® "On Call Air Pickup" page, does not provide any input field or other means for a user to indicate a shipping or pickup date. *See also, e.g., Bennett Decl.*, ¶ 26; *Bennett Decl.*, Exhibit J.

Further, it is respectfully asserted that the operational exemplar UPS® "[UPS] Quick Cost Calculator™" page may be displayed by clicking a "Quick Cost Calculator" link on any of the operational exemplar UPS® web pages for any of the various UPS® delivery service web pages (*e.g.,* UPS Next Day Air®, UPS Next Day Air Early A.M.^{SM}, etc.). *See also, e.g., Bennett Decl.*, ¶¶ 10, 15; *Bennett Decl.*, Exhibits C, F and G. Yet further, it is respectfully asserted that those various UPS® delivery service web pages (*e.g.,* UPS Next Day Air®, UPS Next Day Air Early A.M.^{SM}, etc.) do not provide any Pickup Date or Shipping Date input fields. *See also, e.g., Bennett Decl.*, ¶¶ 12, 17; *Bennett Decl.*, Exhibits C and F.

Still further, as compared to the limitations of amended Claim 64, it is respectfully asserted that the operational exemplars of the UPS® "UPS Quick Cost Calculator™" webpage do not indicate that a calculation of a rate would consider any particular Pickup [or shipping] date, or that any Pickup [or shipping] Date must have been input, such as through the UPS® "On Call Air Pickup™" webpage, in order for a rate to be calculated. *See also, e.g., Bennett Decl.*, ¶ 32; *Bennett Decl.*, Exhibit J.

The Office Action dismissed the previously-filed *Bennett Declaration* as "insufficient to overcome the rejection of claims 64-79 ... ." *Office Action*, Topic No. 16, p. 7.

It is respectfully submitted that the previously-filed Amendment and Response made assertions, as does the current Amendment and Response, regarding an apparent absence of the UPS "Quick Cost Calculator™" page to use any pick-up date from a UPS "On-Call Air Pickup" screen in the calculation of a shipping rate. Those assertions were, and are, supported not only by citations to the previously-filed *Bennett Declaration*, but also by Exhibits to that Declaration. It is respectfully asserted that the Office Action's dispute of the sufficiency of the content of the *Bennett Declaration* does not respond to the assertions made in the previously-filed Amendment and Response, and does not respond to, or dispute, the evidence presented by the Exhibits to the *Bennett Declaration*.

In response to the previously-made assertions regarding the apparent absence by the *UPS* "Quick Cost Calculator™" page to use any pick-up date from a *UPS* "On-Call Air Pickup" screen, the Office Action responds that the *UPS* reference was not argued "as it was applied in the rejection." *Office Action*, Topic No. 16, p. 8. The Office Action concedes that "...UPS does not have one item which does both entering in a ship date and output the rates based on the entered in ship date ..." but asserts that "... [t]he UPS reference as a wh[o]le, given On-Call pickup, the cost calculator, as well as transit times would in fact calculate this information." *Office Action*, Topic No. 16, p. 8. The Office Action asserts that "... the Kara reference as well as all other reference uses shipping dates when making calculations, that is why they can account for Saturday deliveries. It is just not specified that the user actually enters the ship date." *Office Action*, Topic No. 16, p. 8. The Office Action then further asserts that "UPS discloses scheduling a pick up, which would indicate that the user enters in the ship date (the ship date would be the scheduled pick up date), therefore showing that it is old and well known for a user to enter a ship date and for the date to be considered when calculating rates." *Office Action*, Topic No. 16, p. 8. The Office Action, apparently asserting that scheduling a pick up is equivalent to calculating rates, states that "UPS discloses ... calculating rates based on things like shipping date (schedule a pick up) ...." *Office Action*, Topic No. 19, p. 10.

It is respectfully disputed that scheduling a pick up is equivalent to calculating a rate as posited by the Office Action. Further, it is respectfully asserted that, for the

reasons given above, although the <u>UPS On Call</u> reference discloses entry of a pick-up date, which the Office Action equates with a shipping date, and although the <u>UPS</u> "Quick Cost Calculator™" page discloses calculation of a shipping rate, neither the <u>UPS On Call</u> reference nor the *UPS* "Quick Cost Calculator™" page, even when considered in combination, disclose, as asserted by the Office Action, a calculation of a shipping rate that is made "according to [a] shipping date," as claimed by amended independent Claim 64.

The Office Action's assertion that "... the Kara reference as well as all other reference uses shipping dates and considers shipping dates when making calculations, that is why they can account for Saturday deliveries ..." (*Office Action*, Topic No. 16, p. 8) is not clear.

The aforementioned assertion by the Office Action regarding <u>Kara</u>'s consideration of shipping dates and accounting for Saturday deliveries was made without a specific citation to the <u>Kara</u> reference and is respectfully disputed. As compared to the aforementioned assertion by the Office Action, it is respectfully asserted that <u>Kara</u> does not appear to discuss determining that a particular package may be delivered on a Saturday or to discuss any extra charge by one or more carriers for providing a Saturday delivery. Rather, it is respectfully asserted that the above-mentioned reading of <u>Kara</u> posited by the Office Action imports a perspective gleaned from the presently claimed invention as proscribed by the Federal Circuit in *In re Mahurkar*. *Cf. In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

In particular, it is respectfully asserted that even designating an urgency of "Overnight" on a Friday with <u>Kara</u> would not result in a Saturday delivery using, for example, the "FedEx Standard Overnight®" described in <u>FedEx</u> as providing "...delivery by 3:00 p.m. the next business day to thousands of U.S. cities in our primary service area (4:30 p.m. to most of the rest, *Saturday delivery not available with this service*)...." See <u>FedEx</u>, p. 1. Further, even for UPS® services, which may, as described further below, provide in some circumstances for Saturday delivery with an extra charge, it is respectfully asserted that <u>Kara</u> does not expressly disclose consideration of a shipping date in determining a delivery date, or a determination that a particular package may be

delivered on a Saturday, or an option for a user to select a Saturday delivery option for an extra charge, or a calculation that would include any extra charge for delivering a package on a Saturday.

With respect to the *UPS* and *UPS On Call* references, the Office Action's assertion that shipping dates are used and considered in the calculation of a shipping rate is respectfully disputed in that, as described further below, neither of those references appear to determine whether or not a particular package may be delivered on a Saturday – rather, it appears from those references that a user of those references would need to first self-determine whether or not the user's particular package might be delivered on a Saturday; if the user should self-determine that it would be possible to deliver the user's particular package on a Saturday, then the user would need to self-select a Saturday delivery option, such as on the "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* as described further below.

In particular, with respect to the *UPS* reference, it is noted that various of the *UPS* pages, such as, for example, the UPS Next Day Air Early A.M.[SM] and UPS Next Day Air® pages, display what appears to be a "Saturday Delivery" link that is described on those pages as a user option. In particular, it is respectfully asserted that the "Saturday Delivery" link that is described on those pages appears to be an option that may be self-selected by a user in conjunction with a particular UPS® service. Further, it is respectfully asserted that the presence of those "Saturday Delivery" links on those pages does not disclose any rate being calculated with respect to a particular shipping date for a selected service for delivery of a particular package.

With regard to the UPS® exemplars attached to the *Bennett Declaration*, it is respectfully noted that the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* displays a list of optional services that may be selected by the user that includes, among others, Saturday Delivery. See *Bennett Decl.*, Exhibit G, "Optional Services," p. 2. However, it is respectfully asserted that the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* does not provide any input field for inputting, or for otherwise identifying, a shipping date. See *Bennett Decl.*, Exhibit G; *see also Bennett Decl.*, ¶ 17. Further, it is respectfully asserted that the archived operational exemplar

"Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* does not indicate that any delivery date or dates, or delivery time or times, would be determined in connection with the calculation of shipping charges. *See Bennett Decl.*, Exhibit G; *see also Bennett Decl.*, ¶ 17. It is therefore respectfully asserted that none of the *UPS*, *UPS On Call* references or the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* disclose any rate being calculated with respect to a particular shipping date for a selected service.

Moreover, it is respectfully asserted that the input field of the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* for a user-selection of "Saturday Delivery" directly contradicts the assertion by the Office Action that the cited *UPS* reference considers shipping dates in the calculation of a shipping rate. Rather, it is respectfully asserted that the input of a user-indication of a "Saturday Delivery" as provided by the above-referenced "Quick Cost Calculator™" page, shows that the cited *UPS* reference does not consider a shipping date in the calculation of a shipping rate. Quite the contrary, it is respectfully asserted that the "Saturday Delivery" input field indicates that the *UPS* reference requires an input by the user of an indication of a Saturday Delivery in order to calculate a rate with an additional charge for a Saturday delivery. Accordingly, it is respectfully asserted that the cited references fail to disclose, anticipate, teach or suggest determining rates "according to [a] shipping date" as claimed, for example, by Claim 64.

Although the cited *UPS* and *UPS On Call* references may qualify as a prior art reference under Section 103, it is respectfully asserted that, as publications, they may only be used as a prior art reference "... for what is in fact disclosed in it." *Cf. Reading and Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art).

It is respectfully asserted that the assertion by the Office Action that the *UPS* and *UPS On Call* references be read to disclose calculating a shipping rate with respect to a particular shipping date for a selected service, is a reading that gleans such a meaning from the claimed limitations as proscribed by the Federal Circuit in *In re Mahurkar*. *Cf.*

In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Yet further, it is respectfully asserted that inputting data into input fields of the operational exemplar UPS® website page entitled "UPS Quick Cost Calculator™" does not result in a calculation and therefore does not serve to indicate whether or not a rate for more than one delivery service at a time would have been calculated. *See also, e.g., Bennett Decl.*, ¶ 33; *Bennett Decl.*, Exhibits K and L.

Yet further still, it is respectfully asserted that the operational exemplar UPS® website page entitled "UPS Quick Cost Calculator™" does not indicate that a rate for any carrier other than UPS® would be calculated. *See also, e.g., Bennett Decl.*, ¶ 34; *Bennett Decl.*, Exhibit K.

As compared to the *UPS On Call* reference, and even as compared to the consequent "UPS Quick Cost Calculator™" page as depicted in Exhibits G and J to the *Bennett Declaration*, it is respectfully asserted that a calculation of a shipping rate according to a shipping date as claimed, for example, by Claim 64, would be useful over the cited references in that such a calculation would facilitate consideration of different rules for calculating a rate where a service might charge a premium over a standard rate for the service, for example, to deliver on certain days of the week, for example, on a Saturday or Sunday, or on a holiday.

As compared to the above-mentioned advantages by exemplary embodiments of the claimed limitations, it is respectfully asserted that the *UPS* reference and the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Declaration* appear to indicate that a user must self-determine whether the user's package may be delivered on a Saturday, and then, if desired, self-select the Saturday Delivery option, thereby self-requesting a calculation of a rate that would include an extra charge for the user-selected option for Saturday delivery.

For the above-given reasons, it is respectfully asserted that the *UPS On Call* reference, even if considered in combination with the other cited references, does not disclose, anticipate, teach or suggest the combination of limitations claimed by amended independent Claim 64 for determining rates "according to [a] shipping date."

For the above-given reasons, it is therefore respectfully asserted that amended independent Claim 64, and the Claims dependent on it, namely, Claims 65-73, are non-obvious in view of the cited references and are therefore in condition for allowance.

C.   NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE IDENTIFYING DAYS OR DATES, AND/OR TIMES, BY WHICH A PACKAGE WOULD BE DELIVERED ACCORDING TO A SHIPPING DATE AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 68 AND 69, 72-74, 76 AND 79.

It is respectfully asserted that the limitations for identifying a day for delivery according to a particular shipping date as claimed by Claim 68 is not disclosed by any of the cited references, including the *FedEx*, *UPS*, *UPS On Call* and *Barnett* references. *See also*, Claims 72 and 73 for similar limitations. Further, it is respectfully asserted that the limitations for identifying times for delivery according to a particular shipping date as claimed by Claim 69 is not disclosed by any of the cited references, including the *FedEx*, *UPS*, *UPS On Call* and *Barnett* references. *See also* Claims 76 and 79 for similar limitations. Yet further, it is respectfully asserted that there is no disclosure in any of the cited references, including the *FedEx*, *UPS*, *UPS On Call* and *Barnett* references, of "… in response to receiving an input by a user … of a particular destination, a particular shipping date and package specifications for a particular package, identifying a [particular] day according to the input, on which a [particular] carrier would deliver the particular package to the particular destination according to the particular shipping date, if [the particular] carrier were to deliver said package to said particular destination via a first delivery service …" as claimed by amended independent Claim 74.

With respect to the rejection of, among others, Claims 68, 69, 72-74, 76 and 79, the Office Action concedes that "… Kara does not specifically disclose the rates being calculated with respect to day and time, according to the shipping date" (*Office Action*, Topic No. 15, p. 6), but asserts instead, that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day …." *Office Action*, Topic No. 15, pgs. 6-7.

For the reasons given further below, it is respectfully asserted that the above-quoted rejections fail to set forth a *prima facie* case of obviousness of Claims 68, 69,

72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

First, it is respectfully asserted that the asserted disclosure of the *UPS* and *FedEx* references as posited by the Office Action of "… specific services where they are guaranteed delivery by a certain time in the day …" (*Office Action*, Topic No. 15, pgs. 6-7) fails to assert disclosure of the claimed limitations for: a.) identifying a day for delivery according to a particular shipping date as claimed by Claims 68, 72, and 73; b.) identifying times for delivery according to a particular shipping date as claimed by Claims 69, 76 and 79; or c.) " … in response to receiving an input by a user … of a particular destination, a particular shipping date and package specifications for a particular package, identifying a [particular] day according to the input, on which a [particular] carrier would deliver the particular package to the particular destination according to the particular shipping date, if [the particular] carrier were to deliver said package to said particular destination via a first delivery service …" as claimed by amended independent Claim 74.

As compared to the above-mentioned limitations claimed by Claims 68, 69, 72-74, 76 and 79, and as described further below, it is respectfully asserted that the cited references do no more than provide a general description of delivery guarantees that do not indicate a particular date (or time) on which a particular delivery will be made.

It is respectfully asserted that the *FedEx* reference amounts to nothing more than a general description of various services offered by FedEx® and rules that FedEx® applies to shipments. Specifically, *FedEx* lists a number of FedEx® delivery services along with a brief description of each FedEx® delivery service. Further, it is respectfully asserted that the mere description or naming of a carrier's delivery service does not provide a shipping user with a definitive delivery date or delivery time.

For example, *FedEx* describes "FedEx Priority Overnight®" as providing "… delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest). Shipments may weigh up to 150 lbs., and measure up to 119" length and up to 165" in length and girth combined … Pickup and delivery Monday-Saturday". *FedEx*, p. 1.

It is respectfully asserted that the naming of the particular delivery service as an "Overnight" service might be interpreted by some shipping users to indicate that a package would be delivered the very next day. However, even though the particular FedEx® service is named an "Overnight" service, it is respectfully asserted that the guarantee for the "FedEx Priority Overnight®" service described in the *FedEx* reference is actually for "the next business day." It is respectfully asserted that, depending on the day of the week and/or the date an item is shipped, the "next business day" may not be the very next day. Rather, depending on the day of the week and/or the date on which a particular item is shipped, and to some extent, on the time of shipment, the "next business day" may not occur until several days after the shipment. For example, if an item is shipped on a Friday, the next business day would not occur until, at the earliest, three days later, on the following Monday. Further, if the following Monday happened to be a holiday, then the "next business day" would not occur until four days following shipment, on the following Tuesday.

Yet further, it is respectfully asserted that the time of delivery would depend on, among other things, the destination to which a particular item is to be delivered. As described in the *FedEx* reference, the "FedEx Priority Overnight®" service would provide "… delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest)." Therefore, it is respectfully asserted that, depending on the destination city, a shipment of an item using the "FedEx Priority Overnight®" service as described in the *FedEx* reference might be delivered by 10:30 a.m. the next business day, by noon the next business day, or possibly, some other time (in the case that the destination city was neither in the "primary service" or in "most of the rest").

As a further example of the differences between the name of a delivery service, the description of the associated guarantee, and the claimed shipping-date-dependent delivery date, *FedEx* describes "FedEx Standard Overnight®" as providing "…delivery by 3:00 p.m. the next business day to thousands of U.S. cities in our primary service area (4:30 p.m. to most of the rest, Saturday delivery not available with this service). Shipment may weigh up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." *FedEx*, p. 1.

As described above for the "FedEx Priority Overnight®" service, the "FedEx Standard Overnight®" is described as being associated with a "next business day" guarantee that would be shipping date/day-of-the-week dependent; the time of delivery is destination-city-dependent.

As yet another example of the differences between the name of a delivery service, the description of the associated guarantee, and the claimed shipping-date-dependent delivery date, _FedEx_ describes "FedEx 2Day(SM)" as providing "delivery by 4:30 p.m. the second business day (7:30 p.m. to residential destinations) within the continental U.S. Shipments may weight [sic] up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." _FedEx_, p. 1.

Still further, it is respectfully asserted that the _FedEx_ reference is a non-enabling reference with respect to the claimed subject matter of the Claims of the present application, and can therefore not properly be used to support more than it actually discloses. *See Reading and Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art). Therefore, for the above-given reasons, because the _FedEx_ reference only names its services and gives general guarantee descriptions but does not actually determine a shipping-date-dependent delivery date, it is respectfully asserted that the combination of limitations claimed by, for example, Claims 68, 69 and 74, are non-obvious in view of the _FedEx_ reference, even when that reference is combined with the other cited references.

It is respectfully asserted for the reasons given further below that, similar to the _FedEx_ reference, although the text of the _UPS_ reference provides a description of each of its delivery services and the corresponding delivery guarantees, the _UPS_ reference fails to disclose "… in response to receiving an input by a user … of a particular destination, a particular shipping date and package specifications for a particular package, identifying a [particular] day according to the input, on which a [particular] carrier would deliver the particular package to the particular destination according to the particular shipping date, if [the particular] carrier were to deliver said package to said particular destination via a first delivery service …" as claimed by amended independent

Claim 74. And for the reasons given further below, neither does the UPS On Call reference.

According to the UPS and UPS On Call references, and as described above with respect to operational archived exemplars, the UPS® "Quick Cost Calculator" link appears to provide a user with the ability to click the link to obtain a calculation of shipping rates, and "availability and delivery times", for the particular service with which the link appears. However, for the reasons given below, it is respectfully asserted that the indication by the UPS and UPS On Call references of the "Quick Cost Calculator" link still fails to disclose "…identifying a [particular] day according to the input, on which a [particular] carrier would deliver the particular package to the particular destination according to the particular shipping date …" as claimed by amended independent Claim 74.

In particular, for the reasons given further below, it is respectfully asserted that there is no disclosure in the UPS or UPS On Call references, or in operational exemplars of the UPS® "Quick Cost Calculator" discussed further below, that the referenced "availability and delivery times" would be determined according to a particular shipping date as claimed, for example, by amended independent Claim 74.

It is respectfully asserted that the UPS reference, as with FedEx, teaches that, even for "guaranteed" services, different delivery times may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, for the UPS Next Day Air Early A.M.® delivery service, even though UPS states "Guaranteed Overnight by 8 A.M.", UPS clarifies that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to most other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)…" UPS, p. 2, "UPS Next Day Air Early A.M.®" (emphasis added). That is, in order for delivery to be "Guaranteed Overnight by 8 A.M.", assuming the delivery was to occur Monday through Friday, the delivery address would need to be in one of the "major U.S. cities;" in order for delivery to be guaranteed by 8:30 a.m., the delivery address, if not in one of the "major U.S. cities", would need to be in one of the "most other U.S. cities…" UPS, p. 2, "UPS Next Day Air Early A.M.®" (emphasis added).

As another example of guarantee-dependency on shipping particulars, for the UPS Next Day Air® delivery service, even though *UPS* states "Guaranteed Overnight by 10:30 AM", *UPS* clarifies that delivery is guaranteed "...by 10:30 a.m., noon, or end-of-day the next business day *depending on destination* (noon or 1:30 p.m. on Saturdays)." *UPS*, p. 4, "UPS Next Day Air®" (emphasis added). That is, according to *UPS*, delivery time would be dependent on the destination address and the day of the week shipped.

Further, the *UPS* reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in *UPS* for any of the UPS® delivery services. *Compare, e.g., UPS*, p. 2, "UPS Next Day Air Early A.M.®" (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and *UPS*, p. 4. "UPS Next Day Air®" (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), *with UPS*, p. 6, "UPS® 2nd Day Air A.M.®" (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (*see, UPS*, p. 6, "UPS® 2nd Day Air A.M.®"), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day, according to *UPS*, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®" delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in *UPS* as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, *e.g.*, the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days and times for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing by the *UPS* and *UPS On Call* references of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

Further, for the reasons given further below, it is respectfully asserted that references by *UPS* and *UPS On Call* to a "Quick Cost Calculator" link do not disclose a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

The *UPS* and *UPS On Call* references show a "Quick Cost Calculator" link on each separate UPS® delivery and pickup service page. *See also, e.g., Bennett Decl.,* ¶¶ 10, 15, 20; *Bennett Decl.,* Exhibits C, F and H. For example, for the UPS Next Day Air Early A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air Early A.M." *UPS,* p. 2, "UPS Next Day Air Early A.M.®". As another example, for the UPS Next Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." *UPS,* p. 4, "UPS Next Day Air®". As a further example, for the UPS 2nd Day Air A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." *UPS,* p. 6, "UPS® 2nd Day Air A.M.®". Yet further, for the UPS 2nd Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." *UPS,* p. 8, "UPS 2nd Day Air®". For the UPS 3 Day Select® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." *UPS,* p. 10, "UPS 3 Day Select®". For UPS Ground, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." *UPS,* p. 12, "UPS Ground". Similarly, the *UPS On Call* reference states "Refer to the Quick Cost Calculator for the exact cost of your shipment." *UPS On Call,* ¶ 3.

However, it is respectfully asserted that neither the *UPS* Quick Cost Calculator link, nor the corresponding operational exemplars of the UPS® "Quick Cost Calculator™" webpage, as depicted, for example, in Exhibits D, G, and J to the *Bennett Decl.*, appear to have provided any entry for a shipping date or any determination of any shipping-date dependent delivery date (or delivery time for that matter) in connection with any calculation of shipping rates, at least not during the time preceding the present invention. *See, e.g., Bennett Decl.*, Exhibits D, G, and J; *see also, e.g., Bennett Decl.*, ¶¶ 12, 17, and 26.

Yet further, it is respectfully asserted that neither the *UPS On Call* reference nor the operational exemplars of the UPS® "Quick Cost Calculator™" webpage indicate that information under the "Scheduling Information" section of the UPS® "On Call Air Pickup™" webpage must have first been input in order in order to activate the "Quick Cost Calculator" link to calculate a rate. *See also, e.g., Bennett Decl.*, ¶¶ 22-23, 27-28, 31; *Bennett Decl.*, Exhibits H and J.

Further still, for the reasons previously described above, it is respectfully asserted that the operational exemplars of the UPS® "Quick Cost Calculator™" webpage do not indicate that a calculation of a rate would consider any particular Pickup [or shipping] date, or that any Pickup [or shipping] Date must have been input, such as through the UPS® "On Call Air Pickup™" webpage, in order for a rate to be calculated. *See also, e.g., Bennett Decl.*, ¶ 32; *Bennett Decl.*, Exhibit J.

Because, as described above, there is no indication that any shipping or Pickup date is considered in calculating a rate (*see also, e.g., Bennett Decl.*, ¶ 32), or that any shipping-date-dependent delivery date (or delivery time) would be determined by the *UPS* and *UPS On Call* references (or by the UPS® "Quick Cost Calculator™" webpage) (*see also, e.g., Bennett Decl.*, ¶¶ 12, 17, and 26), it is therefore respectfully asserted that the *UPS* reference mention of "availability and delivery times" with respect to the "Quick Cost Calculator" link appears to be a reference to general availability and delivery times, not a delivery date and/or time that is identified or determined according to a particular shipping date as claimed, for example, by Claim 74.

As with the *FedEx* reference, it is respectfully asserted that the *UPS* and *UPS On Call* references are non-enabling references with respect to the claimed subject matter

of the Claims of the present application, and can therefore not properly be used to support more than they actually disclose. See *Reading and Bates*, 748 F.2d at 652.

The Office Action asserts that "UPS was used to show that a user entering a ship date (scheduling an on call pick up), is old and well known." *Office Action*, Topic No. 18, p. 9. The Office Action then asserts that "… if combining UPS with Kara, then you would have the rate being calculated based on the ship date that is entered by the user." *Office Action*, Topic No. 18, p. 9.

It is respectfully asserted that the aforementioned assertion by the Office Action that combining the UPS® On Call pick-up date, equated by the Office Action as a ship date, does not in any way disclose determining delivery dates and times according to the shipping date, as claimed, for example, by Claim 74.

Rather, as previously mentioned above, it is respectfully asserted that the *UPS* reference and the archived operational exemplar "Quick Cost Calculator™" page depicted in Exhibit G to the *Bennett Decl.* appear to indicate that a user must self-determine whether the user's package may be delivered on a Saturday, and then, if desired, self-select the Saturday delivery option and request a calculation of a rate that would include an extra charge for the user-selected option for Saturday delivery.

Therefore, because for the reasons given above there is no indication by the *UPS*, *UPS On Call* or *FedEx* references that a shipping-date-dependent delivery date and/or time is determined, it is therefore respectfully asserted that the *UPS*, *UPS On Call* or *FedEx* references do not disclose, anticipate, teach or suggest the combination of limitations claimed by, for example, Claims 68, 69, 72-74 and 79, and that those Claims, and therefore the Claims that are dependent on them, are therefore non-obvious in view of the *UPS*, *UPS On Call*, and *FedEx* references, even when those references are combined with the other cited references.

D. **INTERSHIPPER FAILS TO DISCLOSE A SIMULTANEOUS DISPLAY OF RATES FOR MULTIPLE DELIVERY SERVICES PROVIDED BY VARIOUS CARRIERS, AND IT WOULD BE IMPROPER TO READ INTO INTERSHIPPER A PRESUMPTION OF SUCH A SIMULTANEOUS DISPLAY OF RATES THAT IS GLEANED FROM THE PRESENT APPLICATION.**

For the following reasons and authorities, it is respectfully asserted that the combination of limitations claimed by Claims 64 and 71 and therefore dependent Claims 65-73, are nonobvious in view of the combination of *Intershipper* with the other cited references because *InterShipper*, even when considered in combination with any of the other cited references, fails to disclose, anticipate, teach or suggest a simultaneous display of rates as claimed by independent Claim 64 (which recites "... simultaneously displaying said first, second, third, and fourth shipping rates to a display device ....") and dependent Claim 71 (which recites "...simultaneously displaying to the display device: (1) said first, second, third and fourth shipping rates; and (2) said first, second, third, and fourth delivery schedule indicia.")

Although the Office Action states that "Kara discloses ... [d]etermining multiple shipping rates ... for a first carrier ... [and] [d]etermining multiple shipping rates for a second carrier ..." (*Office Action*, Topic No. 7, p. 3; *Office Action*, Topic No. 12, p. 5), the Office Action concedes that "Kara ... fails to disclose the simultaneous display of rates for each carrier that includes rates of different services (Column 11, lines 1-13)" (*Office Action*, Topic No. 8, p. 4; *Office Action*, Topic No. 13, pgs. 5-6). The Office Action asserts instead that "Intershipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3)." *Office Action*, Topic No. 8, p. 4; *Office Action*, Topic No. 13, p. 6. The Office Action concedes that "[t]he InterShipper article may not explicitly disclose that the results are displayed on a computer screen ...," but asserts that "... InterShipper discloses all the information being given at one time." *Office Action*, Topic No. 20, p. 10.

The Office Action is apparently asserting that the below-quoted statements should be inferred to indicate that the *InterShipper* reference simultaneously displayed

("all at one time" (*Office Action*, Topic No. 20, p. 10)) its results, and that the
InterShipper reference included multiple delivery services offered by multiple carriers in
its results:

> Internet users can now get shipping rates from all major shippers in just a few
> seconds. Simply enter your origin, anywhere in the U.S. is OK, and destination,
> worldwide, along with your package weight and dimensions. The free service will
> return every method possible that you can use to ship your package and arrange
> the results in cost order, and color code the results by approximate transit time.
> World Wide Web: http//www.wwmerchant.com/iship.

InterShipper, p. 1, ¶2.

However, for the reasons given and under the authorities cited below, it is
respectfully asserted that both such inferences are equally misplaced and unsupported.

Importantly, the cited *InterShipper* reference is a publication, not a U.S. patent.
As such, there is no presumption of enablement as to the disclosure of the cited
InterShipper reference.   Moreover, as to the Claims of the present application, it is
respectfully asserted that the cited *InterShipper* reference is not enabling.

Although the cited *InterShipper* reference may qualify as a prior art reference
under Section 103, it may only be used as a prior art reference "… for what is in fact
disclosed in it."   *Reading and Bates Construction Co. v. Baker Energy Resources
Corp.*, 748 F.2d 645, 652 (Fed. Cir. 1984) (finding a non-enabling promotional brochure
cannot be used as a vehicle for qualifying a later filed patent as prior art).

Under *Reading and Bates*, it is respectfully asserted that, contrary to the
inferences apparently asserted by the Office Action, the *InterShipper* reference never
states that the *InterShipper* service would display its results simultaneously, or "all … at
one time" as asserted by the Office Action (*Office Action*, Topic No. 20, p. 10). Rather,
the *InterShipper* reference states only that "[t]he free service will return every method
possible that you can use to ship your package …." *InterShipper*, p. 1, ¶2. It does not
say that such returned "every method possible" will be simultaneously displayed. or
even that such returned "every method possible" will be displayed "all … at one time" as
asserted by the Office Action (*Office Action*, Topic No. 20, p. 10).

Rather, it is respectfully asserted that the reading of *InterShipper* posited by the
Office Action is one that is based on a perspective gleaned from the present application

as proscribed by the Federal Circuit in *In re Mahurkar*. *Cf. In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. III. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Because the Office Action relied on the *InterShipper* reference to provide the conceded missing link of a simultaneous display absent from the *Kara* reference, in view of the holdings of *In re Mahurkar* and *Reading and Bates*, it is therefore respectfully asserted that the complete absence from the *InterShipper* reference of any statement that the *InterShipper* service will display its results simultaneously, or even that it will return its results "all ... at one time" as suggested by the Office Action, is evidence that the combinations of limitations of Claims 64 and 71, and therefore dependent Claims 65-73, of the present application, are therefore non-obvious in view of the *InterShipper* reference, even when that reference is considered in combination with the other cited references.

Yet further, contrary to the inference apparently asserted by the Office Action that the *InterShipper* reference included multiple delivery services offered by multiple carriers in its results, it is respectfully asserted that the *InterShipper* reference never states that the *InterShipper* service would include multiple delivery services offered by the "major shippers." To the contrary, the *InterShipper* reference specifically states that "Internet users can now get shipping rates from all major shippers ...", not by multiple delivery services offered by multiple major shippers. It is respectfully asserted that the mention by the *InterShipper* reference that "[t]he free service will return every method possible that you can use to ship your package ..." (*InterShipper*, p. 1, ¶2) does not expressly state that the *InterShipper* reference would report a rate for multiple delivery services for multiple carriers. Rather, it is respectfully asserted that "every method possible" could be interpreted to merely refer to "all major shippers" mentioned by the *InterShipper* reference.

Accordingly, in view of the holdings of *In re Mahurkar* and *Reading and Bates*, it is therefore respectfully asserted that the complete absence from the *InterShipper* reference of an express statement that the *InterShipper* service would include multiple delivery services offered by the "major shippers" as suggested by the Office Action, is evidence that the combinations of limitations of Claims 64 and 71, and therefore

dependent Claims 65-73, of the present application, are therefore non-obvious in view of the *InterShipper* reference, even when that reference is considered in combination with the other cited references.

E. *NONE OF THE CITED REFERENCES, EVEN WHEN CONSIDERED IN COMBINATION, DISCLOSE SIMULTANEOUSLY DISPLAYING DELIVERY SCHEDULE INDICIA BY WHICH A PACKAGE WOULD BE DELIVERED ACCORDING TO A SHIPPING DATE AS CLAIMED IN ONE WAY OR ANOTHER BY CLAIMS 68, 69, 73-74, 76 AND 78-79.*

The Office Action indicates that it is relying on the *UPS* and *FedEx* references to disclose determining dates and times for shipments and is only citing *Barnett*, because "... Barnett is simply displaying them in a certain fashion." *Office Action*, Topic No. 21, p. 11. In particular, the Office Action asserts that although "Kara, InterShipper, UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services[,] Barnet[t] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." *Office Action*, Topic No. 15, p. 7. The Office Action further asserts that "[i]t would have been obvious ... to have the display of rates of Kara, InterShipper, UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2)." *Office Action*, Topic No. 15, p. 7.

However, for the reasons given, and under the authorities cited below, it is respectfully asserted that the above-quoted assertion of obviousness does not set forth a *prima facie* case of obviousness as required under MPEP §706.02(j) and MPEP §2143.

First, it is respectfully asserted for the reasons previously given above, that none of the *Kara*, *UPS*, *UPS On Call* and *FedEx* references disclose, anticipate, teach or suggest the limitations for identifying a day, date or times for delivery according to a particular shipping date as claimed in one way or another by Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78.

Therefore, it is respectfully asserted that the asserted combination of *Barnett* with the other cited references fails to set forth a *prima facie* case of obviousness of the claimed limitations.

Further, even if it were assumed for the sake of argument only, that one or a combination of the cited references disclosed the claimed limitations for identifying a day, date or times for delivery according to a particular shipping date, for the reasons given further below, it is respectfully asserted that adding *Barnett* to the combination of asserted references still does not disclose the combination of limitations for simultaneously displaying delivery schedule indicia by which a package would be delivered according to a shipping date as claimed in one way or another by Claims 68, 69, 73-74, 76 and 78-79.

It is respectfully asserted that the combination of limitations of Claims 68, 69, 73-74, 76 and 78-79, are predictive and determinative in nature – that is, the limitations recite using a user input to determine a date and/or time for a future event (a delivery) according to a particular reference date (a shipping date) and claim simultaneously displaying scheduling indicia for such predictive events.

As compared to being predictive or determinative, or displaying scheduling indicia that is predictive in nature, it is respectfully asserted that *Barnett* does not identify or determine a date on which a particular event will occur with respect to a particular reference date, and does not display dates, that are predictive or determinative according to a particular reference date. Rather, it is respectfully asserted that *Barnett* merely reports dates and times on which events with pre-determined schedules are so scheduled to occur.

Yet further, as compared to the limitations of, for example, Claim 68, which by virtue of its dependency on Claim 64, claims limitations for simultaneously displaying shipping rates for each of multiple delivery services offered by each of multiple carriers, *Barnett* does not disclose any simultaneous display of rates (*see e.g., Barnett*, FIG. 9). In fact, it is respectfully submitted that *Barnett* does not disclose any display of rates by the *Barnett* system. Moreover, for the reasons previously given above, it is respectfully asserted that none of the cited references, including *InterShipper* and *Barnett*, even

when considered in combination with the other cited references, disclose a simultaneous display of rates for multiple delivery services offered by multiple carriers.

The Office Action asserts, though, that "Kara and InterShipper disclose calculating and displaying simultaneous display of rates of each carrier of each service, the UPS and FedEx references discloses determining dates and times for shipments. Barnett discloses a calendaring system which displays things on a time and date basis." *Office Action*, Topic No. 21, p. 11.

For the reasons given above, it is respectfully asserted that the complete absence of the combination of limitations recited by Claims 68, 69, 72-74, 76 and 79, from the combination of references asserted by the Office Action, is strong evidence that the combination of limitations recited by Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, are therefore *not* obvious.

As compared to the cited references, it is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, is that such embodiments would allow for a simultaneous cross-comparison of the various schedules according to which a package would be delivered via multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the date on which UPS would deliver a package via an "overnight" delivery service; (2) the date on which UPS would deliver the package via a "second day" delivery service; (3) the date on which Federal Express would deliver the package via an "overnight" delivery service; and (4) the date on which Federal Express would deliver the package via a "second day" delivery service. It is respectfully asserted that such a display may be useful over the cited references in allowing users to quickly compare the days on which a package would actually be delivered if the user were to ship the package on a particular shipping date via one of various delivery services. It is respectfully asserted that such an embodiment would be especially useful if different carriers have different policies regarding, for example,

whether a package sent via overnight delivery on a Friday would be delivered on the next weekday (Saturday) or on the next business day (Monday).

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of Claims 68, 69, 72-74, 76 and 79, and therefore the Claims dependent on them, namely Claims 70-71, 75, 77-78, are not disclosed, anticipated, taught or suggested by any of the cited references, whether considered alone or in combination with any other cited reference, and are therefore non-obvious in view of the cited references, and are therefore in condition for allowance.

F.   THE COMBINATIONS OF LIMITATIONS CLAIMED BY THE REJECTED CLAIMS MEET THE KSR TEST FOR NON-OBVIOUSNESS, YIELDING MORE THAN A SEPARATE APPLICATION BY THE ELEMENTS OF THE CLAIMED LIMITATIONS

In rejecting Claims 64-67, and Claims 68-79, the Office Action asserts that "[i]t would have been obvious ... to modify Kara, to have the ability to schedule a shipping date by the user, as taught by UPS." *Office Action*, Topic No. 9, p. 4; *Office Action*, Topic No. 14, p. 6. The Office Action then cites *KSR* as support for the assertion that Claims 64-67 and 68-79 are a "combination of familiar elements according to known methods ...." *Office Action*, Topic No. 9, pgs. 4-5; *Office Action*, Topic No. 14, p. 6.

First, as previously mentioned above, it is respectfully asserted that the Office Action's assertions regarding disclosure by the *UPS* and/or *UPS On Call* references of scheduling a pickup date are inapposite. The rejected claims are not directed to scheduling a pickup date, but rather, to determining a rate, and depending on the claim, a delivery date and/or a delivery time, *according to a user input comprising a shipping date*.

Further, in addition to the reasons previously given above why the cited references fail to disclose the combination of limitations claimed by the rejected Claims, it is respectfully asserted that the combinations of limitations claimed by the rejected Claims meet the *KSR* test for non-obviousness.

In *KSR*, the Supreme Court acknowledged that "... inventions in most, if not all, instances, rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known."

KSR, 127 S.Ct. at 1741. Accordingly, the *KSR* Court reiterated its caution against hindsight bias and *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. *Accord Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 2008 U.S. App. LEXIS 6786, *14-*15 (Fed. Cir. March 31, 2008) (explaining that "a flexible TSM [teaching, suggestion, or motivation] test remains the primary guarantor against a non-statutory hindsight analysis ...."(citations omitted)).

"[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR*, 127 S.Ct. at 1741. Rather, the *KSR* Court clarified ways in which a claim could be shown to be nonobvious. In particular, the *KSR* Court indicated that combining known elements so that the combination yields more than one would expect from such an arrangement would support nonobviousness. *Cf., KSR* at 1740.

In accordance with the above-outlined *KSR* approach for supporting nonobviousness, it is respectfully asserted that the combination of limitations claimed by, for example, amended independent Claim 64 yields more than a separate application of those elements. In particular, assuming for the sake of argument only that the pickup date of *UPS On Call* discloses input of a shipping date, for reasons similar to those given previously above, it is respectfully asserted that the asserted combination of the asserted pickup date of *UPS On Call*, even if combined with *Kara* would, at most, provide for input of a pickup date and provide for a calculation of shipping rates "... according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. ..." (*Kara*, col. 22, lines 28-32; *see also Kara*, col. 22, lines 39-42) as disclosed by *Kara*.

Yet further, even assuming for the sake of argument only, an equivalency between a scheduled *UPS On Call* pick-up date and a shipping date, because for the reasons previously given above, none of the *UPS*, *UPS On Call* or *FedEx* references even provide for a determination of a delivery date and/or time based on a shipping date, for the reasons similarly provided previously above, it is respectfully asserted that combining the *UPS*, *UPS On Call* and/or *FedEx* references with *Kara* would result in, at most, a calculation of shipping rates "... according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. ..." (*Kara*, col. 22, lines

28-32; *see also* Kara, col. 22, lines 39-42) as disclosed by Kara. It is respectfully asserted that there is no disclosure in any of the cited references, or in any combination of the cited references, that teaches or suggests the combination of limitations claimed by Claim 64 regarding receiving a set of package specifications and an indication of a shipping date, and then *in response to receiving the set of package specifications and the indication of the shipping date*, determining various shipping rates for various delivery services by various carriers according to the shipping date.

It is further respectfully asserted that, in accordance with the above-outlined *KSR* approach for supporting nonobviousness, the combinations of limitations claimed by, for example, amended dependent Claims 68 and 69, yield more than a separate application of those elements. In particular, even assuming for the sake of argument only as described above that the pickup date of *UPS On Call* discloses input of a shipping date, it is respectfully asserted that the asserted combination of the asserted pickup date of *UPS On Call*, even if combined with Kara would, at most, provide for input of a pickup date and provide for a calculation of shipping rates "… according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. …" (Kara, col. 22, lines 28-32; see also Kara, col. 22, lines 39-42) as disclosed by Kara, and would not teach or suggest the combination of limitations claimed by dependent Claim 68 and 69 regarding, for example, identifying days and times by which carriers would deliver a package to a destination, according to a shipping date. As compared to a calculation of shipping rates "… according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. …" (Kara, col. 22, lines 28-32; *see also* Kara, col. 22, lines 39-42) as disclosed by Kara, Claim 68 claims identifying days, and Claim 69 claims identifying times on the identified days, by which delivery would be provided by various delivery services offered by a carrier.

Further, in accordance with the above-outlined *KSR* approach for supporting nonobviousness, it is respectfully asserted that the combination of limitations claimed by, for example, amended independent Claim 74 yields more than a separate application of those elements. In particular, even assuming for the sake of argument only as described above that the pickup date of *UPS On Call* discloses input of a
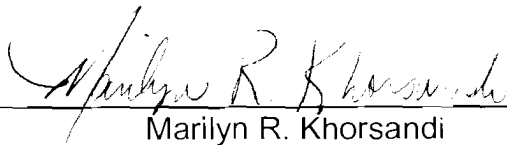
shipping date, it is respectfully asserted that the asserted combination of the asserted pickup date of _UPS On Call_, even if combined with _Kara_ would, at most, provide for input of a pickup date and provide for a calculation of shipping rates "... according to[/commensurate with] the desired shipping and/or delivery parameters, i.e., class, urgency, etc. ..." (_Kara_, col. 22, lines 28-32; _see also Kara_, col. 22, lines 39-42) as disclosed by _Kara_, and would not teach or suggest the combination of limitations claimed by Claim 74 regarding, for example, "...identifying a [particular] day according to the input, on which a [particular] carrier would deliver the particular package to the particular destination _according to the particular shipping date_ ...."

For the above-given reasons, it is therefore respectfully asserted that Claims 64, 74, 68 and 69, and therefore dependent Claims 63-67, 70-73 and Claims 75-79 are non-obvious in view of the cited references and are therefore in condition for allowance.

Conclusion

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed by Claims 64-79 of the present application are not fairly taught by any of the cited references, taken either alone or in combination, are distinguished from, are not obvious in view of, and are therefore patentable over, the cited references. Accordingly, it is respectfully asserted that the application is condition for allowance. Accordingly, reconsideration and allowance of Claims 64-79 are respectfully requested.

Respectfully submitted,
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